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ATTORNEY DOCKET NO. 10030511-1

ITW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Theodore R. Sana, et al.

Serial No.: 10/722,155

Examiner: Young J. Kim

Filing Date: November 25, 2003

Group Art Unit: 1637

Title: Methods and Apparatus for Preparing Arrays Comprising Features Having Degenerate Biopolymers

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- ☒ Response/Amendment ☐ Petition to extend time to respond
☐ New fee as calculated below ☐ Supplemental Declaration
☐ No additional fee (Address envelope to "Mail Stop Amendments")
☐ Other: (Fee \$_____)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X 50	\$ 0
INDEP. CLAIMS		MINUS		= 0	X 200	\$ 0
<input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ 360	\$ 0
EXTENSION FEE	1 ST MONTH 120.00 <input type="checkbox"/>	2 ND MONTH 450.00 <input type="checkbox"/>	3 RD MONTH 1020.00 <input type="checkbox"/>	4 TH MONTH 1590.00 <input type="checkbox"/>		\$ 0
OTHER FEES						\$ 0
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 50-1078. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 50-1078 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 50-1078 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,

Theodore R. Sana, et al.

By

Theodore J. Leitereg
Theodore J. Leitereg

Attorney/Agent for Applicant(s)

I hereby certify that this correspondence is being Deposited with the United States Postal Service as First class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: July 26, 2006

Typed Name: Theodore J. Leitereg

Signature: *Theodore J. Leitereg*

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Date: July 26, 2006

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CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450, on July 26, 2006.

Signature

Date

Name: Theodore J. Leitereg

PATENTS
Attorney Docket No. 10030511-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Theodore R. Sana, *et al.*

Serial No.: 10/722,155

Group Art Unit: 1637

Confirmation No.: 8586

Examiner: Young J. Kim

Filed: November 25, 2003

Title: Methods and Apparatus for Preparing Arrays Comprising Features Having Degenerate Biopolymers

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Response to Restriction Requirement

This paper is responsive to the Restriction Requirement in the Office Action dated June 27, 2006, from the U.S. Patent and Trademark Office in the above-identified patent application.

Restriction Requirement

Restriction was required under 35 U.S.C. §121 as follows:

Group I – Claims 1-9, drawn to a method of synthesizing a plurality of biopolymers, wherein one or more biopolymers are degenerate biopolymers, classified in class 536, subclass 25.3.

Group II - Claim 10, drawn to an array of biopolymers, wherein at least one of one of the biopolymers comprises degenerate biopolymers, classified in class 536, subclass 24.33.

Group III - Claims 11 and 12, drawn to a method of detecting a target nucleic acid with an array comprising degenerate biopolymers, classified in class 435, subclass 6.

Group IV - Claims 13 and 26, drawn to a data set, which is an assay result, classified in class 702, subclass 20.

Group V - Claims 14-16, drawn to a method of transmitting data, classified in class 716, subclass 12.

Group VI - Claims 17-22, drawn to a method of synthesizing a plurality of oligonucleotides on a substrate, wherein the oligonucleotides are phylogenetically related, classified in class 536, subclass 25.3.

Group VII - Claim 23, drawn to an array of oligonucleotides comprising oligonucleotides, wherein the array comprises phylogenetically related oligonucleotides, classified in class 536, subclass 24.33.

Group VIII - Claims 24 and 25, drawn to a method of detecting phylogenetically related target nucleic acid, classified in class 435, subclass 6.

Group IX - Claims 27-30, drawn to a method of synthesizing an array of oligonucleotides and its apparatus, classified in class 536, subclass 25.3.

Group X - Claims 31 and 32, drawn to a method for normalizing the results of binding reactions involving a plurality of samples and plurality of arrays, classified in class 702, subclass 104.

Response to Restriction Requirement

In making the Restriction Requirement, a determination was made that the inventions of the various groups are distinct each from the other. According to M.P.E.P. 802.01 the term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (emphasis in original). Accordingly, in making the restriction requirement the Office Action is acknowledging at least implicitly that the inventions of the aforementioned groups are separately patentable over one other. If this were not the case, then the restriction requirement would not be proper. It is noted that the Office Action does use the phrase "patentably distinct" in some occurrences. However, for the restriction requirement to be proper, all of the groups must be patentably distinct and separately patentable over one another.

Furthermore, it follows from the above that art (if such art exists) indicating that the invention of one of the groups is known or would have been obvious would not extend to a holding that the inventions of the other groups are known or would have been obvious. For

example, art that might anticipate or render obvious a method for detecting a target nucleic acid sequence as set forth in claim 11 utilizing an array of claim 10 would not render known or obvious an array as claimed in claim 10 (and claims depending therefrom) or vice versa. Again, if this were not the case, then the restriction requirement with respect to those claims would not be proper.


Likewise, art that might anticipate or render obvious a method for synthesizing a plurality of oligonucleotides at predetermined sites on a surface of a substrate wherein one or more of the sites comprise a mixture of oligonucleotides that are phylogenetically related as set forth in claim 17 (and claims depending therefrom) would not render known or obvious a method of synthesizing a plurality of biopolymers at predetermined feature locations on a surface of a substrate wherein one or more of the feature locations comprises degenerate biopolymers as set forth in claim 1 (and claims depending therefrom) or vice versa. Again, if this were not the case, then the restriction requirement with respect to those claims would not be proper.

Likewise, art that might anticipate or render obvious a method for detecting a target nucleic acid sequence as set forth in claim 24 using an array of claim 23 would not render known or obvious an array according to claim 23 (and claims depending therefrom) or vice versa. Again, if this were not the case, then the restriction requirement with respect to those claims would not be proper.

The aforementioned rationale may be applied to claims in any one of the groups identified in the Restriction Requirement with regard to claims in any of the other groups identified in the Restriction Requirement.

In response to and as required by the Restriction Requirement, Applicant elects the invention of Group I, Claims 1-9 with traverse. Applicant reserves the right to file divisional patent applications to the subject matter that the Office Action has determined to be patentably distinct and separately patentable.

Respectfully submitted,


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